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11  
12 **UNITED STATES DISTRICT COURT**  
13 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**  
14 **SAN FRANCISCO DIVISION**  
15

16 NORTHPEAK WIRELESS, LLC,  
17 Plaintiff,  
18 v.  
19 3COM CORPORATION, *et al.*,  
20 Defendants.  
21  
22

Case No: 3:09-cv-00602-CRB

**NOTICE OF MOTION AND MOTION  
TO STAY THE CASE PENDING  
REEXAMINATION OF THE PATENTS-  
IN-SUIT**

Judge: The Honorable Charles R. Breyer  
Courtroom 8, 19th Floor  
Hearing Date: September 4, 2009  
Time: 10 a.m.

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**NOTICE OF MOTION AND MOTION**

On Friday, September 4, 2009, at 10:00 a.m., or as soon thereafter as the matter may be heard, in Courtroom 8 of the United States District Court for the Northern District of California, 450 Golden Gate Avenue, San Francisco, California 94102, the undersigned defendants and intervenor (collectively, “Defendants”) will and do move to stay the case pending resolution of requests for reexamination by the United States Patent and Trademark Office (the “PTO”) of U.S. Patent Nos. 4,977,577 and 5,987,058 (together, the “patents-in-suit”).

A stay pending reexamination of the patents-in-suit by the PTO is sought so as to preserve the Court’s time and resources, to spare the parties considerable expense, to permit the validity of the patents to be considered by examiners knowledgeable in the technology, and to simplify or eliminate issues for trial.

**MEMORANDUM OF POINTS AND AUTHORITIES**

**I. SUMMARY OF ARGUMENT**

The patents-in-suit are now the subject of requests for reexamination before the PTO. These reexaminations will likely cancel all of the patent claims, allowing this case to end without any further proceedings—no technology tutorials, claim construction, discovery, expert reports, summary judgment or trial. Staying this action pending reexamination is therefore appropriate.

The two patents-in-suit were developed by a company that sold fire alarms and are both directed to a “fire warning and detection system.” NorthPeak, a technology licensing company that acquired the fire alarm patents, now alleges that they cover all products that comply with a wireless networking standard called “802.11b.” NorthPeak’s overly broad construction, however, is ultimately self-defeating because it encompasses 1970s-era technology, among other prior art, rendering the asserted claims invalid. NorthPeak’s novel claim interpretation was not presented to the PTO in the original applications, nor did the PTO consider the prior art that forms the basis of the reexamination requests. Reexamination will permit specialized examiners knowledgeable in the technology to consider the validity of the patents in view of this new evidence. Only a small minority of patents emerge from reexamination unscathed, and it is

likely that the PTO will invalidate the claims asserted here—mooting this case entirely. Even if some claims survive, there will likely be fewer to litigate, and the additional prosecution history will aid the Court in claim construction.

A stay of this action would not prejudice NorthPeak. The accused wireless networking standard, 802.11b, was adopted a decade ago. Yet the original patentee never suggested that its fire alarm patents apply to 802.11b products, much less attempted to enforce them against Defendants—many of whom started selling such products shortly after the 802.11b standard was released. The patents have now expired, and NorthPeak seeks only monetary relief. If the asserted claims survive reexamination, such relief remains available, and NorthPeak cannot complain about any incremental delay caused by a stay. In contrast, granting the stay will conserve the resources of the Court and the parties by avoiding litigation over claims that are unlikely to survive reexamination.

## II. BACKGROUND

### A. The Patent Applications.

Our story begins in 1988, when Axonn Corporation filed the first of the patent applications at issue. The patents were narrowly drawn to a “wireless fire warning and detection system.” [Devkar Decl. Exs. A (‘577 patent at col. 1:7), B (‘058 patent at col. 1:16)] Axonn’s fire alarm was hardly groundbreaking, and even the named inventors vigorously disagreed with each other about whether the claimed inventions were patentable. Inventor James Arthur flat-out declared in a letter to his co-inventors that the claims of the second application were invalid:

[G]iven the prior art, what we invented, and the disclosure in the specification, I don’t think any of the claims are appropriate. . . . I am very concerned about my liability with the Patent Office if I sign this without stating my beliefs regarding the claims. ***I could not truthfully say that I think these claims describe valid inventions.***

[Devkar Decl. Ex. C (8/12/96 letter from J. Arthur to H. Sanderford) (emphasis supplied)] The patents subsequently issued with claims covering the fire alarm system disclosed in the application. The patents nowhere mention or disclose using spread spectrum technology for

1 anything other than a one-way transmission alarm system, aside from a passing phrase that  
2 mentions a “local area network data link.” [Devkar Decl. Exs. A (‘577 patent col. 4:66-67), B  
3 (‘058 patent at col. 5:3)]

4 Axonn aggressively enforced the patents against its competitors in the wireless alarm  
5 space. For example, here in the Northern District of California, Axonn fought a seven-year legal  
6 battle against several of its alarm system competitors, accusing them of (among other things)  
7 infringing one of the patents now in suit. *Life Point Sys., Inc. v. Cargill, Inc.*, Case No: 93-20352  
8 JW (N.D. Cal.). However, Axonn never attempted to assert the patents against wireless  
9 computer networks with multi-way communication.

#### 10 **B. The 802.11b Standard.**

11 Beginning in the late 1980’s, the Institute of Electrical and Electronics Engineers  
12 (IEEE)—the world’s leading professional organization for the advancement of computer  
13 technology—began work on a new standard for wireless computer networks. In 1999, IEEE  
14 released a version of the networking standard called “802.11b.” Axonn was aware of 802.11b at  
15 least as early as 2001, when it distinguished its own technology as a supposedly superior  
16 alternative. [Devkar Decl. Ex. D (10/4/01 “Reliable Wireless Connectivity for Sensing &  
17 Control Applications,” by H. Sanderford and G. Hill of Axonn)] Yet even though Axonn  
18 aggressively asserted its patents against alarm system competitors, it never asserted them  
19 against—or even suggested that they covered—802.11b products. Although 802.11b quickly  
20 became very popular, it has long since been displaced by updated IEEE standards not accused of  
21 infringement in this case.

#### 22 **C. NorthPeak.**

23 NorthPeak does not sell any products at all, much less any products that practice the  
24 patents-in-suit. [Devkar Decl. Ex. E (Response to Interrogatory No. 2)] NorthPeak’s only assets  
25 are five patents—including the two patents-in-suit—that it acquired from Axonn, all of which are  
26 entitled “Wireless Alarm System.” See <http://www.northpeakwireless.com>.

**D. The Lawsuit.**

NorthPeak acquired the patents-in-suit less than a month before suing Defendants. [Devkar Decl. Ex. F (Extract of Assignment)] No one appears to have ever suggested before the filing of this action that these fire alarm patents cover 802.11b wireless computer networking products. Neither Axonn nor NorthPeak ever gave Defendants notice of the patents or proposed a license. This lawsuit came out of the blue. [Devkar Decl. Ex. E (Response to Interrogatory No. 4)]

Rather than filing this case in this District, where the patents had previously been litigated and where many of the parties are located, NorthPeak went forum-shopping. It filed suit in Alabama even though no party—including NorthPeak itself—or witness is located there. The court in Alabama transferred the case to this District, finding that the relevant factors weighed “considerably” in favor of transfer. [Dkt. 224 at 15]

The case is still in its early stages. No depositions have been scheduled. The *Markman* hearing is six months away, and no trial date has been set.

**E. The Reexamination Requests.**

In its infringement contentions, NorthPeak contends that *any* product that complies with 802.11b infringes the asserted claims of the patent because the standard provides for data packets to be transmitted using a packet format that includes preamble, address and data fields, and direct sequence spread spectrum (DSSS) modulation. [Devkar Decl. Ex. J (Preliminary Infringement Contentions at 2)] But the use of DSSS transmissions with that type of packet format was well known long before the first patent application was filed in 1988. Indeed, those basic features were disclosed in 1974 in a report published by F.H. Dickson of the Collins Radio Company about a wireless networking system sponsored by the U.S. government. [Devkar Decl. Ex. G (‘577 Reexamination Petition at 8-12)] Those same features were also subsequently disclosed as background in a patent covering other aspects of a wireless local area network system developed by Telesystems SLW. [*Id.* at 13-17] Neither the Dickson report nor the Telesystems patent was before the PTO during prosecution of the patents-in-suit.



1 If the asserted claims are inappropriately stretched to cover 802.11b, they necessarily  
 2 cannot be valid because they would also cover packet radio technology dating back to at least the  
 3 1970s. Furthermore, the patents-in-suit are still invalid even given a proper, narrower  
 4 construction because the 1974 Dickson report and the Telesystems patent disclose or make  
 5 obvious the specific circuit structures recited in the claims of the patents-in-suit. On July 28,  
 6 2009, Intel filed a petition relying on these prior art references asking the PTO to reexamine all  
 7 asserted claims of the '577 patent, and, by the time the Court considers this motion, it will have  
 8 filed a petition to reexamine the '058 patent based on the same prior art. [Devkar Decl. Ex. G  
 9 ('577 Reexamination Petition)]

### 10 **III. ARGUMENT**

#### 11 **A. Because Reexamination Promotes the Specialized, Efficient Determination of** 12 **Patent Validity, Stays Pending Reexamination Are Liberally Granted.**

13 The 1980 Patent Act created procedures that enable a party to ask the PTO to reexamine  
 14 the validity of an issued patent. One of Congress's principal goals was to "allow courts to refer  
 15 patent validity questions to the expertise of the Patent Office." *Patlex Corp. v. Mossinghoff*, 758  
 16 F.2d 594, 601-02 (Fed. Cir. 1985). Congress specifically intended to promote the "efficient  
 17 resolution of questions about the validity of issued patents without recourse to expensive and  
 18 lengthy infringement litigation." H.R. Rep. No. 96-1307 at 3-4. Reexamination in the PTO  
 19 enables validity to be determined by "the most expert opinions and at a much reduced cost." *Id.*;  
 20 *see also ASCII Corp. v. STD Entm't USA, Inc.*, 844 F. Supp. 1378, 1380 (N.D. Cal. 1994)  
 21 (reexamination is intended "'to provide an inexpensive, expedient means of determining patent  
 22 validity which, if available and practical, should be deferred to by the courts'"); *Nanometrics,*  
 23 *Inc. v. Nova Measuring Instruments, Ltd.*, No. C-06-2252 SBA, 2007 WL 627920, at \*1 (N.D.  
 24 Cal. Feb. 26, 2007) ("Congress instituted the reexamination process to shift the burden [of]  
 25 reexamination of patent validity from the courts to the PTO.'").

26 When a petition for reexamination is filed, the PTO first determines whether the cited  
 27 prior art raises a substantial new question of patentability, and, if so, then reexamines the claims

1 in accordance with the procedures used for an initial examination. 35 U.S.C. § 303(a).  
 2 However, whereas an initial examination is conducted by a single examiner, a reexamination is  
 3 conducted by three (including a supervisory examiner), who “are selected from the ranks of the  
 4 PTO examiner corps and have an average of approximately 17 years of examining experience.”  
 5 [Devkar Decl. Ex. H (R. Sterne, et al., “Reexamination Practice with Concurrent District Court  
 6 or USITC Patent Litigation” (2008) at 28-29)]

7 For *ex parte* petitions like the one that Intel has filed here, the PTO proceeds with a  
 8 reexamination 92% of the time. [Devkar Decl. Ex. I (*Ex Parte* Reexamination Filing Data –  
 9 June 30, 2009)] In 75% of the cases, the PTO goes on to either cancel or change the claims that  
 10 it has reexamined. *Id.* In other words, patents emerge unchanged from *ex parte* reexaminations  
 11 only a quarter of the time.

12 In light of the intent of Congress, the expertise of the PTO, and the efficiency of  
 13 reexamination, there is a “liberal policy” in favor of staying patent lawsuits pending  
 14 reexamination. *ASCII Corp.*, 844 F. Supp. at 1381; *Nanometrics*, 2007 WL 627920, at \*1 (the  
 15 legislative history “evinces congressional approval of district courts liberally granting stays”).  
 16 Indeed, “[t]he stay of pending litigation to enable PTO review of contested patents was one of  
 17 the specified purposes of the reexamination legislation.” *Patlex Corp.*, 758 F.2d at 606;  
 18 *Nanometrics*, 2007 WL 627920, at \*1 (a stay allows the court to take advantage of the “PTO’s  
 19 specialized expertise to reduce costly and timely litigation”).

20 There is an “impressive surfeit of case law favoring stays” early in patent cases. *Tse v.*  
 21 *Apple Inc.*, No. C-06-06573 SBA, 2007 WL 2904279, at \*4 (N.D. Cal. Oct. 4, 2007). The policy  
 22 in favor of stays is so strong that courts regularly grant them even before the PTO has decided  
 23 that it will reexamine the patent. *See, e.g., id.* at \*5; *Hewlett-Packard Co. v. Acuson Corp.*, No.  
 24 C-93-0808 MHP, 1993 WL 149994, at \*4 (N.D. Cal. May 5, 1993); *SP Techs., LLC v. HTC*  
 25 *Corp.*, No. 08-C-3760, 2009 WL 1285933, at \*2 (N.D. Ill. May 6, 2009); *Cross Atl. Capital*  
 26 *Partners, Inc. v. Facebook, Inc.*, 2008 WL 3889539, at \*3 (E.D. Pa. Aug. 18, 2008). In at least  
 27 one instance, this Court has issued a stay *before* the defendant had even formally sought

1 reexamination, based on the defendant's stated intention to file such a petition. *ASCII*, 844 F.  
2 Supp. at 1381.

3 **B. The Court Should Stay This Case Pending Reexamination.**

4 Courts consider three factors in determining whether to stay a patent case pending  
5 reexamination: (1) whether a stay will simplify the issues; (2) whether discovery is complete  
6 and a trial date has been set; and (3) whether a stay would unduly prejudice or present a clear  
7 tactical disadvantage to the non-moving party. *In re Cygnus Telecomms. Tech., LLC*, 385 F.  
8 Supp. 2d 1022, 1023 (N.D. Cal. 2005); *Nanometrics*, 2007 WL 627920, at \*2; *Tse*, 2007 WL  
9 2904279, at \*2. All three factors weigh in favor of a stay here.

10 **1. A stay will likely simplify the issues, if not moot the case entirely.**

11 A stay is "particularly justified" where reexamination might eliminate the need for a trial  
12 by cancelling the claims or might "assist the court in determining patent validity." *Cygnus*, 385  
13 F. Supp. 2d at 1023; *KLA-Tencor Corp. v. Nanometrics, Inc.*, No. C-05-03116 JSW, 2006 WL  
14 708661, at \*4 (N.D. Cal. Mar. 16, 2006) (granting stay because it would "simplify the issues and  
15 streamline the trial, thereby reducing the burden on, and preserving the resources of both the  
16 parties and the Court."). That is certainly the case here.

17 The weaknesses of the patents-in-suit are manifest in light of the expansive scope that  
18 NorthPeak is attempting to give them. By seeking to stretch these two fire alarm patents to cover  
19 802.11b computer products, NorthPeak is applying them so broadly that they encompass radio  
20 technology that was developed in the 1970s—and that therefore invalidates them. If the PTO  
21 agrees that the claims are invalid, this case will end. No discovery. No claim construction. No  
22 tutorial on direct sequence spread spectrum technology. No expert reports. No dispositive  
23 motions. No trial. *Target Therapeutics, Inc. v. SciMed Life Sys., Inc.*, No. C-94-20775 RPA  
24 (EAI), 1995 WL 20470, at \*2 (N.D. Cal. Jan. 13, 1995) (absent a stay, "the court may waste time  
25 examining the validity of claims which are modified or eliminated altogether during  
26 reexamination").

1 The likelihood that the claims will be cancelled here is even greater than usual because  
 2 the patents-in-suit have expired. During reexamination, NorthPeak will not be able to “fix” the  
 3 claims to overcome the PTO’s objections to patentability. 37 C.F.R. § 1.530(j) (“No amendment  
 4 may be proposed for entry in an expired patent.”).

5 Even should some claims survive, reexamination will help clarify the scope of the  
 6 remaining claims and provide guidance in understanding the prior art. *Gould v. Control Laser*  
 7 *Corp.*, 705 F.2d 1340, 1342 (Fed. Cir. 1983) (dismissing appeal of stay order and noting that one  
 8 purpose of the reexamination procedure is to provide “the district court with the expert view of  
 9 the PTO (when a claim survives the reexamination proceeding)”; *Cygnus*, 385 F. Supp. 2d at  
 10 1024 (reexamination can give the court “a richer prosecution history” for claim construction  
 11 determinations); *Nanometrics*, 2007 WL 627920, at \*3 (reexamination can “facilitate the trial by  
 12 providing the Court with the opinion of the PTO and clarifying the scope of the claims”). For  
 13 example, the reexamination proceedings will create additional “intrinsic evidence” relevant for  
 14 claim construction. *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1158 (Fed. Cir. 1997)  
 15 (during reexamination, a patentee may “commit to a particular meaning for a patent term, which  
 16 meaning is then binding in litigation”); *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858,  
 17 867-69 (Fed. Cir. 2004) (citing statements made by patentee during reexamination to support the  
 18 district court’s claim construction and judgment of non-infringement).

## 19 **2. This case is in its early stages.**

20 The Initial Case Management Conference was only two months ago, and no trial date has  
 21 been set. Claim construction briefing has not started, and the *Markman* hearing is six months  
 22 away. No depositions have been taken or even scheduled. No dispositive motions have been  
 23 filed. These facts favor a stay. *See, e.g., ASCII Corp.*, 844 F. Supp. at 1380 (citing with  
 24 approval a case in which the court had granted a stay 16 months after the suit had been filed);  
 25 *Tse*, 2007 WL 2904279, at \*2 (a stay is “particularly appropriate” where there has been little  
 26 discovery); *KLA-Tencor*, 2006 WL 708661, at \*2 (the fact that the parties had not yet conducted  
 27 “significant discovery” favored a stay).

Nor can there be any suggestion of undue delay by Defendants. Intel timely sought reexamination after NorthPeak served its preliminary infringement contentions, which identified for the first time which of the 100+ claims in the patents NorthPeak would be asserting and exposed just how broadly NorthPeak is attempting to apply those claims. The reexamination petition was filed a month before the deadline for preliminary invalidity contentions. *See Cygnus*, 385 F. Supp. 2d at 1023-24 (no undue delay where case had been pending “over a year” before a reexamination petition was filed); *Tse*, 2007 WL 2904279, at \*4 (no undue delay where reexamination was sought three months after service of preliminary invalidity contentions).

### 3. A stay will not prejudice NorthPeak.

This case is solely about money. NorthPeak does not make or sell any products or services. It is not at risk of suffering competitive injury. Because the patents have expired, all of NorthPeak’s alleged damages occurred in the past, and it cannot seek an injunction. In the event that NorthPeak does prevail in this case, its remedy will be limited to money. Courts have “consistently” held that technology licensing companies like NorthPeak “cannot be prejudiced by a stay because monetary damages provide adequate redress for infringement.” *Implicit Networks, Inc. v. Advanced Micro Devices, Inc.*, No. C 08-00184 JLR, 2009 WL 357902, at \*3 (W.D. Wash. Feb. 9, 2009) (collecting cases).

Courts also have repeatedly rejected claims of prejudice that were based solely on the ground that reexamination would delay final adjudication of the lawsuit. *E.g., Sorensen v. Black & Decker Corp.*, No. 06cv1572 BTM (CAB), 2007 WL 2696590, at \*4 (S.D. Cal. Sept. 10, 2007) (granting stay where plaintiff’s claims of prejudice “boil down to his inconvenience in delaying final collection of any monetary award of royalties, assuming he ultimately wins”); *Photoflex Prods., Inc. v. Circa 3 LLC*, No. C 04-03715 JSW, 2006 WL 1440363, at \*2 (N.D. Cal. May 24, 2006) (“The delay inherent to the reexamination process does not constitute, by itself, undue prejudice.”); *Nanometrics*, 2007 WL 627920, at \*3 (“Mere delay, without more though, does not demonstrate undue prejudice.”).

Moreover, a stay would be relatively short. The PTO is required to conduct reexaminations with “special dispatch.” 35 U.S.C. §§ 305, 314. The PTO gives the “highest priority” to reexamination of patents involved in litigation, such as those at issue here, and response deadlines are shortened. Manual of Patent Examining Procedure at §§ 2261-63. NorthPeak cannot complain about a relatively brief additional delay in having its claims adjudicated (assuming that the patents do in fact survive reexamination). In fact, should the PTO invalidate all the asserted patent claims, NorthPeak would actually have benefited from a stay because it would have avoided the expense of engaging in concurrent, and ultimately fruitless, litigation. *See, e.g., Implicit Networks*, 2009 WL 357902, at \*2 (“Granting a stay ‘allow[s] [for] the reexamination of patent validity in an impartial forum at almost 100 times less cost to the parties by people trained to understand the technologies described in the patents.’”).

NorthPeak’s claims of prejudice would ring especially hollow because the short delay inherent to the reexamination process pales in comparison to the decade that passed before the patents were first asserted against the 802.11b standard. Even then, NorthPeak further slowed things down by forum-shopping and filing this case in a venue that had no connection to the claims or parties. NorthPeak’s own delay is fatal to any claim of supposed prejudice. *See Acuson Corp.*, 1993 WL 149994, at \*2 (plaintiff’s “ten year delay in seeking to protect its patented interests weighs heavily against denying Acuson’s motion for stay”).

#### IV. CONCLUSION

The Court should stay this case pending reexamination because a stay will promote judicial economy, will simplify the issues (if not dispose of the case entirely), and will not prejudice NorthPeak.

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**Consent to Filing Pursuant to General Order 45(X)**

I, Andrew V. Devkar, hereby attest that written concurrence to the filing of this Motion has been obtained from each of the parties listed in the foregoing signature block.

Dated: July 31, 2009

/s/ Andrew V. Devkar

Andrew V. Devkar

**CERTIFICATE OF SERVICE**

***NorthPeak Wireless, LLC v. 3COM Corp., et al.***

**U.S. District Court, Northern District of California, Case No. 3:09-CV-00602-CRB**

I hereby certify that on July 31, 2009, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will automatically send e-mail notification of such filing to all counsel who have entered an appearance in this action.

/s/ Andrew V. Devkar

Andrew V. Devkar